

REMARKS

Abstract and Acknowledgment of Consideration of References

The Applicants provide an abstract for the application conforming to the requirements of MPEP §608.01(b). The Applicants also acknowledge the Examiner's consideration of the references in the corresponding application's Search Report (Paper No. 2).

Amendments to the Claims

Claim 1 is cancelled; Applicants reserve the right to prosecute the claim in a related continuing application. Claims 2-18, 20, and 22 are amended as method claims that depend ultimately from claim 21. Claims 21 and 23 are amended in the form of independent method claims. Claim 19 is also amended in the form of an independent claim. As well, the phrase "fused benz ring" is replaced with the phrase "fused benzene ring" throughout the claims. With these amendments, the claims conform the requirements of 35 U.S.C. §112, second paragraph.

Claim 23

The Applicants note that the office action and restriction requirement have only referred to claims 1-22 and not claim 23, which was entered with the national phase application. The Applicants respectfully request examination of claim 23, as presently amended in the listing of claims herewith. If the same restriction requirement is applied to claim 23, Applicants elect Group VI, drawn to benzodioxan compounds (A=B=O) and T = phenyl.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 2-4 and 7-22 are rejected as being anticipated by PCT application WO 95/07274 to Kerrigan et al (herein "Kerrigan"). In particular, the rejected claims are directed toward "[a] method of reducing cravings to food or an addictive substance." The

Action states that Kerrigan teaches using the compounds “for the treatment of drug abuse, drug addiction and eating disorders.”

Claims 2-4 and 7-22 are patentable over Kerrigan, however, because reducing a craving for food or an addictive substance is not the same a treatment for drug abuse, drug addiction, or an eating disorder. Drug abuse, drug addiction, and eating disorders encompass a broad, generic range of behaviors that may be treated without reducing a craving for food or an addictive substance. For example, drug abuse and drug addiction may be treated by mitigating some withdrawal symptoms patients may experience while not regularly taking the drug (e.g., shivering, emotional sensitivity, abnormal body vital signs), though not necessarily affecting the “craving” for a drug. In another example, an eating disorder which results in obesity may be treated by accelerating an individual’s metabolism, or changing the specific type of food ingested, without any change in the “craving for food” that an individual possesses. In another eating disorder, bulimia, a treatment may reduce the tendency for a patient to induce vomiting, while not necessarily “reducing the craving for food.”

Furthermore the claimed methods of “reducing cravings to food or an addictive substance” may be utilized outside the context of treating drug addiction, drug abuse, or an eating disorder. For example, the method may also treat a person who is obese because of an abnormally low metabolic rate by helping to reduce their consumption of food, though the person is not necessarily suffering from an eating disorder.

Kerrigan provides a broad generic statement that the compositions revealed may have utility in treating drug addiction, drug abuse, and eating disorders but the reference provides no examples showing the compositions actually treating any of these conditions. Indeed, the only experiments mentioned in Kerrigan refer to assessing the binding interaction of compounds with various receptors of rats (Kerrigan, pages 31 – 39), and making the various chemical compositions (Kerrigan, pages 40 – 93). Kerrigan provides no specific teaching that the compositions are used as a method for reducing cravings for food or an addictive substance. In contrast, the pending application (see pages 12 – 16) provides specific experiments on rhesus monkeys that support the claimed methods of “reducing cravings to food and addictive substances.”

Thus claims 2-4 and 7-22 are not anticipated by Kerrigan because a teaching of treating obesity does not anticipate a treatment for reducing a craving for food.

Conclusion

In light of the aforementioned amendments and arguments, claims 2-23 are hereby submitted for acceptance. The Applicants' representative requests the courtesy of a telephone interview, if the Examiner believes such would expedite the prosecution of the application.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Charlton Shen', with a long horizontal flourish extending to the right.

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